

Attorney Docket No. P13966-US2  
Customer Number 27045

### **REMARKS/ARGUMENTS**

#### **1.) Claim Amendments**

The Applicants have amended claims 1, 11, 13, 14, 16-18, 33, 38, and 40. Claims 12 and 39 have been canceled. Accordingly, claims 1-11, 13-38, and 40-57 are pending in the application. Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

#### **2.) Claim Rejections – 35 U.S.C. § 102(e)**

##### **Hunzinger**

The Examiner rejected claims 1-3, 5, 6, 8, 19, 21, 24-26, 28-33, 35-37, 47-51 and 53-55 under 35 U.S.C. § 102(e) as being anticipated by Hunzinger, et al. (US 6,748,217). The Applicants have amended the claims to better distinguish the claimed invention from Hunzinger. The Examiner's consideration of the amended claims is respectfully requested.

Regarding claim 1, the Examiner stated that the abstract of Hunzinger shows the claim limitations of "determining combined requirements of the communication device" and "mapping the information related to the available access points with the position and the combined requirements of the communication device to obtain mapped information". The Applicants respectfully disagree, but have amended claim 1 to clarify the term "combined requirements".

Amended claim 1 clarifies that the combined requirements include service and application requirements of a service and application requested by the communication device. Basis for this amendment is found in the originally filed specification on page 9, paragraph 0027. The Examiner equated the combined requirements of the communication device with Hunzinger's "service availability". However, these are two entirely different things. Hunzinger's "service availability" refers to whether or not service is available through a selected system. (Col. 6, lines 26-35). The Applicants' "combined requirements" on the other hand refers to network requirements of a service and application requested by the communication device.

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Thus, the "combined requirements" as defined in amended claim 1 are not taught or suggested by Hunzinger. Therefore, the allowance of amended claim 1 is respectfully requested.

Claims 2-3, 5, 6, 8, 19, 21, 24-26, and 28-32 depend from amended claim 1 and recite further limitations in combination with the novel and unobvious elements of claim 1. Therefore, the allowance of claims 2-3, 5, 6, 8, 19, 21, 24-26, and 28-32 is respectfully requested.

Independent claim 33 has been amended to recite a network including a node, wherein the node receives a position and combined requirements of the communication device. The combined requirements include service and application requirements of a service and application requested by the communication device. The node determines access points that are capable of serving the position of the communication device while satisfying the combined requirements of the communication device, and provides the communication device with information related to the determined access points.

Once again, the use of such combined requirements to select an access point is not taught or suggested by Hunzinger, which selects access systems based on position and whether service is available through the selected system. Therefore, the allowance of amended claim 33 is respectfully requested.

Claims 35-37, 47-51 and 53-55 depend from amended claim 33 and recite further limitations in combination with the novel and unobvious elements of claim 33. Therefore, the allowance of claims 35-37, 47-51 and 53-55 is respectfully requested.

#### Agre

The Examiner rejected claims 1, 10, 11, 16, 19, 33, 35, 38, 42 and 43 under 35 U.S.C. § 102(e) as being anticipated by Agre, et al. (US 6,208,857). The Applicants respectfully disagree, and contend that Agre does not teach or suggest the use of combined requirements, as recited in amended claims 1 and 33, to select an access point.

In the Examiner's analysis of claim 1, the Examiner skipped the step in claim 1 of "determining combined requirements of the communication device" and did not point out

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where Agre discloses this limitation. The Applicants contend that Agre does not teach or suggest this limitation.

Regarding the step of "mapping the information related to the available access points with the position and the combined requirements of the communication device to obtain mapped information", the Examiner equates this to the "negotiation" process in Agre and points to Agre FIGS. 3A-B, ref. 110-132; and col. 4, line 62 to col. 5, line 47. However, these passages do not teach or suggest the use of combined requirements of the communication device, as recited in amended claims 1 and 33, to select an access point. Instead, Agre identifies a service provider based on location of the subscriber unit and a confidence factor regarding the reliability of the location information. (Col. 5, lines 22-24). Service provider "negotiation" is required only if there is more than one available service provider. (Col. 6, lines 16-20). If so, the gateway negotiates with the subscriber unit to allow the subscriber unit to select one of the available service providers. (Col. 6, lines 22-25). Thereafter, the subscriber unit selects a most preferred service provider by comparing against a pre-stored list. (Col. 6, lines 55-57).

This process is entirely different from the Applicants' claimed invention. At the very least, the steps of "determining combined requirements of the communication device" and "mapping the information related to the available access points with the position and the combined requirements of the communication device to obtain mapped information" are not taught or suggested by Agre. Therefore, the allowance of amended claims 1 and 33 is respectfully requested.

Claims 10, 11, 16, and 19 depend from amended claim 1 and recite further limitations in combination with the novel and unobvious elements of claim 1. Therefore, the allowance of claims 10, 11, 16, and 19 is respectfully requested.

Likewise, claims 35, 38, 42 and 43 depend from amended claim 33 and recite further limitations in combination with the novel and unobvious elements of claim 33. Therefore, the allowance of claims 35, 38, 42 and 43 is respectfully requested.

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Pinard

The Examiner rejected claims 1, 19, 33, 35 and 37 under 35 U.S.C. § 102(e) as being anticipated by Pinard, et al. (US 6,580,700). The Applicants respectfully disagree, and contend that Pinard does not teach or suggest the use of combined requirements, as recited in amended claims 1 and 33, to select an access point.

In the Examiner's analysis of claim 1, the Examiner again skipped the step in claim 1 of "determining combined requirements of the communication device" and did not point out where Pinard discloses this limitation. The Applicants contend that Pinard does not teach or suggest this limitation.

Regarding the step of "mapping the information related to the available access points with the position and the combined requirements of the communication device to obtain mapped information", the Examiner pointed to Pinard col. 6, line 36 to col. 36[?] (no such column in Pinard). The Applicants' reading of Pinard indicates that Pinard selects access points based on signal strength (RSSI) and to maximize the data throughput. (Col. 2, lines 41-43; col. 5, line 62 to col. 6, line 19; FIG. 5). Pinard maximizes the throughput by selecting the access point with the lowest load factor. (Col. 6, lines 20-35).

This process is entirely different from the Applicants' claimed invention. At the very least, the steps of "determining combined requirements of the communication device" and "mapping the information related to the available access points with the position and the combined requirements of the communication device to obtain mapped information" are not taught or suggested by Pinard. Therefore, the allowance of amended claims 1 and 33 is respectfully requested.

Claim 19 depends from amended claim 1 and recites further limitations in combination with the novel and unobvious elements of claim 1. Therefore, the allowance of claim 19 is respectfully requested.

Likewise, claims 35 and 37 depend from amended claim 33 and recite further limitations in combination with the novel and unobvious elements of claim 33. Therefore, the allowance of claims 35 and 37 is respectfully requested.

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Engwer

The Examiner rejected claims 33 and 35 under 35 U.S.C. § 102(e) as being anticipated by Engwer, et al. (US 5,987,062). The Applicants respectfully disagree, and contend that Engwer does not teach or suggest the use of combined requirements, as recited in amended claim 33, to select an access point.

Amended claim 33 recites a system that includes a communication device capable of communicating using a first and second access technology; and a network including a node, wherein the node receives a position and combined requirements of the communication device. The combined requirements include service and application requirements of a service and application requested by the communication device. The node determines access points that are capable of serving the position of the communication device while satisfying the combined requirements of the communication device, and provides the communication device with information related to the determined access points for networks which use the first or second access technology.

The Applicants note, firstly, that the Examiner has equated both the communication unit and the network node with a mobile unit. This is improper because the Applicants have claimed the communication unit and the network node as two different elements in this apparatus-type claim. In addition, the claim recites that the network node communicates with the communication device; therefore they cannot be the same entity. Thus, for a § 102 rejection, Engwer must disclose a network node, separate from the communication device, that performs the recited functions. The Applicants contend that Engwer does not disclose or suggest such a network node. Therefore, the allowance of amended claim 33 is respectfully requested.

Claim 35 depends from amended claim 33 and recites further limitations in combination with the novel and unobvious elements of claim 33. Therefore, the allowance of claim 35 is respectfully requested.

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### **3.) Claim Rejections – 35 U.S.C. § 103(a)**

#### **Hunzinger/Harris**

The Examiner rejected claims 4, 7, 9, 20, 22 and 34 under 35 U.S.C. § 103(a) as being unpatentable over Hunzinger in view of Harris, et al. (US 6,331,972). The Examiner contends that Harris shows limitations of these claims not shown by Hunzinger. However, neither Hunzinger nor Harris teach or suggest the use of combined requirements, as recited in amended base claims 1 and 33, to select an access point. Therefore, Hunzinger and Harris do not establish a prima facie case of obviousness. (MPEP 2143). Therefore, the withdrawal of the rejection and the allowance of claims 4, 7, 9, 20, 22, and 34 are respectfully requested.

#### **Hunzinger/Agre**

The Examiner rejected claims 10, 11, 15, 16, 18, 38, 41-44 and 46 under 35 U.S.C. § 103(a) as being unpatentable over Hunzinger in view of Agre. The Examiner contends that Agre shows limitations of these claims not shown by Hunzinger. However, neither Hunzinger nor Agre teach or suggest the use of combined requirements, as recited in amended base claims 1 and 33, to select an access point. Therefore, Hunzinger and Agre do not establish a prima facie case of obviousness. (MPEP 2143). Therefore, the withdrawal of the rejection and the allowance of claims 10, 11, 15, 16, 18, 38, 41-44 and 46 are respectfully requested.

#### **Hunzinger/Agre/Harris**

The Examiner rejected claims 14, 17, 23 and 45 under 35 U.S.C. § 103(a) as being unpatentable over Hunzinger in view of Agre, and further in view of Harris. The Examiner contends that Harris shows limitations of these claims not shown by Hunzinger and Agre. However, neither Hunzinger, Agre, nor Harris teach or suggest the use of combined requirements, as recited in amended base claims 1 and 33, to select an access point. Therefore, Hunzinger, Agre, and Harris do not establish a prima facie case of obviousness. (MPEP 2143). Therefore, the withdrawal of the rejection and the allowance of claims 14, 17, 23 and 45 are respectfully requested.

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#### Hunzinger/Agre/Pinard

The Examiner rejected claims 12, 13, 39 and 40 under 35 U.S.C. § 103(a) as being unpatentable over Hunzinger in view of Agre, and further in view of Pinard. The Examiner contends that Pinard shows limitations of these claims not shown by Hunzinger and Agre. However, neither Hunzinger, Agre, nor Pinard teach or suggest the use of combined requirements, as recited in amended base claims 1 and 33, to select an access point. Therefore, Hunzinger, Agre, and Pinard do not establish a prima facie case of obviousness. (MPEP 2143). Therefore, the withdrawal of the rejection and the allowance of claims 12, 13, 39 and 40 are respectfully requested.

#### Hunzinger/Vaara

The Examiner rejected claim 52 under 35 U.S.C. § 103(a) as being unpatentable over Hunzinger in view of Vaara, et al. (US 6,321,083). The Examiner contends that Vaara shows limitations of these claims not shown by Hunzinger. However, neither Hunzinger nor Vaara teach or suggest the use of combined requirements, as recited in amended base claims 1 and 33, to select an access point. Therefore, Hunzinger and Vaara do not establish a prima facie case of obviousness. (MPEP 2143). Therefore, the withdrawal of the rejection and the allowance of claim 52 are respectfully requested.

#### Grube/Hunzinger

The Examiner rejected claims 56 and 57 under 35 U.S.C. § 103(a) as being unpatentable over Grube, et al. (US 5,594,947) in view of Hunzinger. The Examiner contends that Hunzinger shows limitations of these claims not shown by Grube. However, neither Grube nor Hunzinger teach or suggest the use of combined requirements, as recited in amended base claims 1 and 33, to select an access point. Therefore, Grube and Hunzinger do not establish a prima facie case of obviousness. (MPEP 2143). Therefore, the withdrawal of the rejection and the allowance of claims 56 and 57 are respectfully requested.

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#### 4.) Prior Art Not Relied Upon

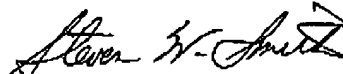
The Examiner stated that the prior art made of record and not relied upon is considered pertinent to the Applicants' disclosure. However, the Applicants' reading of these references did not reveal any teaching or suggestion of the use of combined requirements, as recited in amended base claims 1 and 33, to select an access point.

#### CONCLUSION

In view of the foregoing remarks, the Applicants believe all of the claims currently pending in the Application to be in a condition for allowance. The Applicants, therefore, respectfully request that the Examiner withdraw all rejections and issue a Notice of Allowance for claims 1-11, 13-38, and 40-57.

The Applicants request a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,



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